

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

**UNITED STATES PATENT AND TRADEMARK
OFFICE**

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

GDH/gdh

Mailed: May 8, 2006

Opposition No. 91122465
Opposition No. 91156483
Opposition No. 91159112

Mini Melts, Inc.¹

v.

Dippin' Dots, Inc.

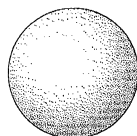
Before Seeherman, Quinn and Hohein, Administrative Trademark
Judges.

By Hohein, Administrative Trademark Judge:

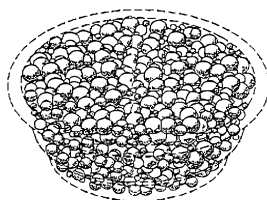
As a preliminary matter, these three oppositions are hereby consolidated, pursuant to Fed. R. Civ. P. 42(a), inasmuch as the parties in each proceeding are the same, the issues presented involve common questions of law and fact, and neither party will be prejudiced by consolidation. See TBMP §511 (2d ed. rev. 2004). Such proceedings may accordingly be presented on the same record and briefs.

¹ Inasmuch as the request is uncontested and is properly supported, plaintiff's request in Opposition No. 91122465 that its name in the caption thereof and in the pleadings of such proceeding be changed from Frosty Bites, Inc. to Mini Melts, Inc., in view of the subsequent amendment of its articles of incorporation to so change its name, is approved. See TBMP §512.02 (2d ed. rev. 2004).

By way of background, Opposition No. 91122465 involves an application filed by Dippin' Dots, Inc. ("applicant") to register the matter shown below as a mark for "ice cream beads less than 10mm in diameter and sold in composite form":²



Opposition No. 91156483 involves an application filed by applicant to register the matter reproduced below as a mark for "ice cream and frozen yogurt":³

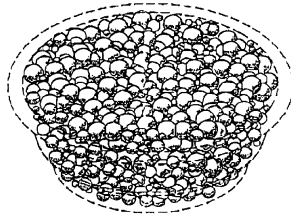


Similarly, Opposition No. 91159112 involves an application by applicant to register the matter illustrated below as a mark for "ice cream, frozen yogurt and novelty frozen water beads":⁴

² Ser. No. 75893686, filed on January 4, 2000, which alleges a date of first use anywhere and in commerce of 1988 and sets forth the following description: "The mark consists of a configuration of the goods which are in the shape of a sphere. The stippling is for shading purposes only and does not indicate color."

³ Ser. No. 78114652, filed on March 13, 2002, which alleges a date of first use anywhere and in commerce of March 31, 1988 and recites the following description: "The mark consists of a configuration of the goods which is in the shape of multiple sphere[s] of ice cream or frozen yogurt beads less than 10mm in diameter and sold in composite form. The beads in the drawing are in the color pink. The broken lines on the drawing indicate a container and are intended to show placement of the mark, and are not a feature of the mark. The stippling is for shading purposes."

⁴ Ser. No. 76137546, filed on September 28, 2000, which alleges a date of first use anywhere and in commerce of 1988 and contains the following description: "The mark consists of a configuration of the



Mini Melts, Inc. ("opposer") has opposed registration in each instance⁵ on the grounds that it "is in the business of manufacturing cryogenically frozen ice cream, yogurt and novelty frozen water particles"; that the matter which applicant seeks to register as a mark is a configuration of applicant's goods;⁶ that "the configuration sought to be registered by Applicant is functional and therefore cannot be registered under 15 U.S.C. § 1052(e)(5)"; that "[a]pplicant claims to be the owner of United States Patent 5,126,156 issued to Curt D. Jones for a method of cryogenically freezing and serving frozen beads of ice cream and other compositions"; that "[t]ogether with Curt D. Jones, Applicant has sued Opposer and others in MDL 1377, *In re Dippin' Dots, Inc. Patent Litigation*, in the United States District Court

goods which is in the shape of multiple spheres of various sizes, in the color brown. The broken lines on the drawing indicate a container and are intended to show placement of the mark, and are not a feature of the mark. The stippling is for shading purposes."

⁵ Opposition No. 91122465 commenced on March 25, 2001, while Opposition Nos. 91156483 and 91159112 respectively commenced over two years later on April 28, 2003 and May 17, 2003.

⁶ In Opposition No. 91122465, opposer specifically alleges that, based upon the description of the proposed mark in the opposed application, "[t]he configuration to be registered is for a single sphere or bead of ice cream, yogurt or novelty frozen water," while in Opposition Nos. 91156483 and 91159112, opposer adds in each case the allegation that its "particles are in the shape of beads and irregularly shaped particles" and that, based upon applicant's respective descriptions of its proposed marks in the involved applications, "[t]he configuration to be registered is for a cup sized grouping of particles."

Opposition Nos. 91122465, 91156483 and 91159112

for the Northern District of Georgia, for patent infringement based upon allegations that Opposer and others made and served beads of ice cream"; that "[o]pposer and others have sued for declaratory judgments of non infringement and patent invalidity ...";⁷ and that "[t]he prosecution history of the '156 patent, including a declaration by Curt D. Jones, demonstrates [that] the configuration depicted in the [involved] trade dress registration application is functional." Opposer, in connection with both Opposition Nos. 91156483 and 91159112, further alleges that:

On March 31, 2003, the MDL 1377 Court granted summary judgment to Opposer and others that ... [Applicant's] product trade dress, claimed as "small round beads or pieces of colorful ice cream," was functional and not entitled to trade dress protection

In addition, Opposer and others have sued Dippin' Dots, Inc. in *Frosty Bites, Inc. et al. v. Dippin Dots, Inc.* 3:01:CV-1532-M (N.D. Tex) for, *inter alia*, declaratory judgments that the Dippin' Dots, Inc. product trade dress is functional. Motions for Summary Judgments by both sides have been filed in this proceeding and these motions for summary judgment are ripe for judicial determination.

Applicant, in its answers, has admitted the allegation in Opposition Nos. 91122465 and 91159112 that opposer "is in the business of manufacturing cryogenically frozen ice cream, yogurt and novelty frozen water particles," but has curiously denied such allegation in Opposition No. 91156483. Additionally, while

⁷ Such allegation, which is from opposer's pleading in Opposition No. 91122465, reads as follows in its later-filed oppositions: "Opposer and others have counter-sued for declaratory judgments of non infringement of the '156 patent and ... [applicant's] claimed trade dress, [and] patent invalidity"

Opposition Nos. 91122465, 91156483 and 91159112

applicant has denied nearly all of the other salient allegations of each opposition, in Opposition No. 91159112 applicant has admitted the allegations of (i) its ownership of the '156 patent; (ii) its filing suit for patent infringement against opposer and others in the MDL 1377 action (styled *In re Dippin' Dots, Inc. Patent Litigation*) in the United States District Court for the Northern District of Georgia; (iii) its being counter-sued in such action by opposer and others for, *inter alia*, patent invalidity and "trade dress ... violations"; (iv) the granting by "the MDL 1377 Court ... [of] summary judgment on the issue of trade dress protection for Applicant's product " (although applicant "notes that this decision is being appealed to the Eleventh Circuit Court of Appeals"); and (v) the filing by "[o]pposer ... [of] suit against applicant in *Frosty Bites, Inc. et al. v. Dippin' Dots, Inc.*, 3:01:CV-1532-M (N.D. Texas)."

Prior to the commencement of testimony periods in connection with Opposition No. 91122465, applicant filed a motion for suspension of such proceeding pending "the final decision of MDL 1377, *In Re Dippin' Dots, Inc. Patent Litigation*, in the United States District Court for the Northern District of Georgia." Applicant asserted, as the basis therefor, that it "believes there are issues before the MDL 1377 Court which may be dispositive of the trademarks [sic] registrability before the ... Board." In support thereof, applicant submitted a copy of a "Transfer Order" issued by the Judicial Panel on Multidistrict Litigation which centralized in the Northern District of Georgia eight district court actions, in which applicant and/or opposer

Opposition Nos. 91122465, 91156483 and 91159112

were parties, based on a finding that "all actions in this litigation involve common questions of fact arising out of Allegations that Frosty Bites beaded ice cream product infringes U.S. Patent 5,126,156 or trade dress for Dippin' Dots small, beaded, free-flowing ice cream product." Opposer, in response, indicated that it did not oppose applicant's motion for suspension in view of such litigation, provided that certain specified preconditions were met. The Board, in an order issued on May 8, 2003, granted applicant's motion for suspension pursuant to Trademark Rule 2.117(a), finding that:

Based on the record now before us, it appears that the civil action and this opposition proceeding involve common legal and factual issues involving the functionality of the applicant's asserted configuration mark. The Court's findings and decision on these issues will be binding on the Board. Thus, the outcome of the civil action clearly will have a bearing on this opposition proceeding.

The Board accordingly suspended proceedings in Opposition No. 91122465 "pending the ultimate outcome" of the parties' civil litigation, "i.e., following the termination of any and all appeals and remands," with the Board to be notified in writing of the final determination of such action within twenty days thereof. However, in connection with Opposition Nos. 91156483 and 91159112, neither applicant nor opposer requested suspension of such proceedings, even though it is apparent that the parties' civil litigation likewise clearly has a bearing upon, if not in fact would be dispositive of, the issue of the functionality of applicant's asserted marks as involved therein. Nonetheless, in consequence of the lack of suspension, all trial

dates in the latter two opposition proceedings have now run and additionally, in connection with Opposition No. 91156483, an order was issued on November 1, 2004 which allowed opposer thirty days from such date to show cause why its failure to file a brief in connection with such proceeding should not be treated as a concession of the case.

Opposer, with respect to all three proceedings, has submitted essentially the same paper as (i) its timely response to the suspension order in Opposition No. 91122465, (ii) its timely reply to the show cause order in Opposition No. 91156483 and (iii) its "BRIEF IN OPPOSITION" in Opposition No. 91159112. For instance, referring to applicant as "DDI," opposer asserts as follows in its response to the suspension order (footnote omitted):⁸

Opposer submits that the relevant portion of the MDL 1377 proceeding has been decided. Additionally, opposer submits that the case should proceed directly to decision because the issue of functionality of DDI's trade dress is controlled by the holding of the Eleventh Circuit in *Dippin' Dots, Inc. v. Frosty Bites Distribution, LLC*, 369 F.3d 1197; 70 U.S.P.Q.2d (BNA) 1707 (11th Cir. 2004), *cert denied*, 125 S. Ct. 911 (2005).

In particular, based on the description in the application involved in Opposition No. 91122465 that applicant's "mark consists of a configuration of the goods which are in the shape of a sphere" and that applicant seeks registration thereof for

⁸ Also, among other things, "Opposer suggests that consolidation with Opposition 91159112 ... and Opposition 91156483 ... would be suitable as all three oppositions are ready for decision based upon the holding of the Eleventh Circuit" in *Dippin' Dots Inc. v. Frosty Bites Distribution LLC*, 70 USPQ2d 1707 (11th Cir. 2004).

goods identified as "ice cream beads less than 10mm in diameter and sold in composite form," opposer notes that (footnotes omitted):

The Eleventh Circuit held:

After a careful review of the record, we conclude that DDI's product design is functional as a whole and in its individual elements. To hold otherwise runs counter to intellectual property law because it would give DDI "a monopoly more effective than that of the unobtainable patent."

The Eleventh Circuit addressed the size, color, and shape of DDI's product. In regard to size, the Eleventh Circuit stated "[s]ize is also functional in this case because it contributes to the product's creamy taste, which would be different in a larger [']dot.[']" In regard to shape the Eleventh Circuit stated "[l]ikewise, the shape of dippin' dots is functional because dripping the ice cream composition into the freezing chamber, as described in Patent '156, creates a [']bead['] that facilitates the product's free flowing nature.["]

Opposer consequently concludes that, in light of applicant's stated "limitations regarding the size and shape of its product configuration in the description portion of Application 75/893,686," "[e]ach of these recitations individually, or collectively, are functional under the decision of the Eleventh Circuit."

Similarly, in reply to the show cause order in Opposition No. 91156483, opposer states that it has not lost interest in such case. Rather, and as is the case in Opposition

Opposition Nos. 91122465, 91156483 and 91159112

No. 91159112, opposer maintains that each proceeding "is ready for a decision based upon the pleadings, Applicant's description [of the mark in the involved application] as filed, and the holding of the Eleventh Circuit" (footnote omitted) in the above noted litigation involving the parties. Specifically, in addition to the holdings mentioned above, opposer points out that, "[i]n regard to color, the Eleventh Circuit stated ... [that] color is functional because it indicates the flavor of the ice cream, for example, pink signifies strawberry, white signifies vanilla, brown signifies chocolate, etc." Because applicant's description of its mark in the application involved in Opposition No. 91156483 refers to "beads ... in the color pink" and describes its goods as "multiple sphere[s] of ice cream or frozen yogurt beads ... sold in composite form," while the involved application in Opposition No. 91159112 describes the mark as consisting of "a configuration of the goods which is in the shape of multiple spheres of various sizes, in the color brown," opposer insists that such marks "are functional under the decision of the Eleventh Circuit."

Although applicant has not filed any paper in response to opposer's submissions in connection with Opposition No. 91122465 and Opposition No. 91156483, it has submitted a response with respect to Opposition No. 91159112, which will be treated as applicable to these consolidated proceedings. By such response, applicant essentially contends that opposer has failed to submit any proper evidence as proof of its allegations of functionality. Specifically, applicant asserts among other things that:

Opposer cites as evidence a Summary Judgment Opinion of the U.S. District Court for the Northern District of Georgia from MDL No. 1377, *In re Dippin' Dots Patent Litigation*, in footnote number one of its Brief. The Summary Judgment Opinion was attached to Opposer's Notice of Opposition when filed [in Opposition No. 91159112 as well as in Opposition No. 91156483].

Opposer also cites as evidence an Opinion by the Eleventh Circuit Court of Appeals upholding the District Court's decision regarding the Applicant's trade dress as decided in the Summary Judgment Opinion. Opposer attached a copy of this opinion to its Brief [in Opposition No. 91159112 and to its reply to the order to show cause in Opposition No. 91156483, cited to such opinion in its response to the suspension order in Opposition No. 91122465,] and referenced the Eleventh Circuit's opinion in footnote number two of its Brief.

During the course of this Opposition [as well as that of Opposition No. 91156483], Opposer conducted no discovery. During its testimony period [in such proceedings], Opposer failed to submit any testimony to Applicant or to the Board, either in the form of oral or written testimony or through filing a Notice of Reliance on any type of evidence.

Applicant, citing Trademark Rule 2.122(b)(1), argues with respect thereto that "[i]n an Opposition ... Proceeding before the Board, the only matters that are automatically of record outside the testimony periods and Notice of Reliance procedure are the Subject Application ... and the pleadings of the Opposition" Applicant, in view thereof and in light of Trademark Rule 2.122(e), consequently maintains that "Official records, such as the opinions used by Opposer, that a party wishes to rely on [in] its briefing or at [final] hearing must be

submitted during the party's testimony period or rebuttal period using a Notice of Reliance." Furthermore, applicant urges that:

An exhibit attached to a pleading in an Opposition is not evidence unless identified and submitted during the parties' testimony period[s]. Trademark Rule 2.122(c). Opposer attached the Summary Judgment Opinion of the District Court to its Notice of Opposition [in both Opposition No. 91156483 and Opposition No. 91159112]. However, Opposer never submitted the Summary Judgment ... [Opinion] during its testimony period as part of a Notice of Reliance. Therefore, the Summary Judgment Opinion Opposer relies upon in its Brief [in Opposition No. 91159112, in its reply to the show cause order in Opposition No. 91156483 and in its response to the suspension order in Opposition No. 91122465] was not properly submitted into the record and should be ignored by the Board.

Likewise, applicant urges that because "[a]n exhibit attached to a party's Brief [or its reply to a show cause order or its response to a suspension order] is also not considered of record in a proceeding," the Board "should not consider any such exhibit as evidence unless submitted by the party during its testimony period." Thus, applicant contends that because "[t]he Opinion of the Eleventh Circuit Court of Appeals ... was never submitted during a testimony period, nor was it submitted as part of a Notice of Reliance during a testimony period," "the Eleventh Circuit's Opinion is not of record in this matter." Applicant accordingly concludes that, in each of these consolidated proceedings:

Opposer has failed to submit any evidence of record in this matter, other than Applicant's Application and the pleadings of this case. Therefore, Opposer failed to support its burden to show that the Mark is

functional, and therefore not entitled to registration.

[Opposer] ... relies entirely on improper evidence that is not of record in this proceeding. Therefore, Applicant respectfully requests that the Opposition be dismissed, and that Applicant's Mark be registered on the Principal Register of the United States Patent and Trademark Office.

Aside from the fact that, in Opposition No. 91122465, proceedings were suspended at applicant's request, prior to the commencement of trial, on the basis that the civil litigation involving the parties would have a bearing upon, if not in fact be dispositive of, the issue of functionality in such proceeding, applicant is simply incorrect in its insistence that the citable opinion of the Eleventh Circuit in connection with the parties' civil litigation is evidentiary in nature. Rather, such opinion is precedential in that it is not only binding on the Board but, more importantly, is binding on the parties under the doctrines of res judicata (or claim preclusion) and collateral estoppel (or issue preclusion). See, e.g., Whopper-Burger, Inc. v. Burger King Corp., 171 USPQ 805, 807 (TTAB 1971). The Eleventh Circuit's opinion cited by opposer constitutes a binding judicial determination that, as between the parties thereto, including applicant and opposer, the marks asserted therein by applicant are functional. Hence, inasmuch as the same marks are the subjects of these consolidated proceedings, which are brought on the identical grounds of functionality, we find that applicant is barred from obtaining the registrations which it seeks as a matter of law.

Tellingly, nowhere in applicant's response does applicant show or even otherwise contend that the parties' civil litigation is not final with respect to the Eleventh Circuit's affirmance of the District Court's grant of summary judgment in opposer's favor as to the claim or issue of functionality. Moreover, it is clear from the Eleventh Circuit's opinion that the matter which applicant seeks to register as its marks has been finally determined to be functional and, in view thereof, is not registrable. For instance, as the Board noted in *Polaroid Corp. v. C & E Vision Services Inc.*, 52 USPQ2d 1954, 1956 (TTAB 1999):

The doctrine of claim preclusion (or res judicata) precludes the relitigation of a claim (or cause of action) which was litigated in a prior proceeding involving the same parties or their privies for which a final judgment "on the merits" has been entered. *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318, 1321 (TTAB 1990). Additionally, "the doctrine of issue preclusion (or collateral estoppel) operates to preclude the relitigation, by the same parties or their privies, of the issues actually litigated, and necessarily determined (by a court of competent jurisdiction), in a prior proceeding" *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1583 (TTAB 1987).

In particular, as to the application of the doctrine of issue preclusion (or collateral estoppel), the Board, citing *Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394, 397 (Fed. Cir. 1983), pointed out in *Polaroid* that the following requirements are essential for application of such doctrine: "(1) the issues to be concluded are identical to those involved in the prior action; (2) in that action the issues were

raised and 'actually litigated'; (3) the determination of those issues in the prior action was necessary and essential to the resulting judgment; and (4) the party precluded ... was fully represented in the prior action." 52 USPQ2d at 1957. Each of such requirements is fully met herein.

Among other things, it is noted from the opinion by the Eleventh Circuit that, as to the matters previously referred to by opposer (footnotes omitted):

Plaintiff-Appellant Dippin' Dots, Inc. ("DDI") brought suit against Defendant-Appellee Frosty Bites Distribution, LLC ("FBD") alleging trade dress infringement of DDI's product design ... in violation of the Lanham Act, 15 U.S.C. §1125. The district court granted summary judgment in favor of FBD For the reasons that follow, we affirm the judgment of the district court.

....

Plaintiff DDI markets and sells a brightly-colored flash-frozen ice cream product, called "dippin' dots," consisting of free flowing small spheres or beads of ice cream. Curtis Jones, DDI's founder, applied for and received Patent No. 5,126,156 ("Patent '156") for the method DDI uses to make dippin' dots. DDI is the exclusive licensee of Patent '156.

....

Defendant FBD makes and sells a competing brightly-colored flash-frozen ice cream product, called "frosty bites," consisting of mostly small popcorn-shaped, along with some spherical-shaped, ice cream bites.

....

DDI filed suit against FBD alleging infringement of DDI's trade dress ... in the form of its unique, flash-frozen ice cream product ... in violation of the Lanham Act,

15 U.S.C. §1125. FBD moved for summary judgment.

The district court granted FBD's motion for summary judgment finding that ... DDI's product design--small, predominantly separated colored beads or pieces of ice cream--is functional and therefore not subject to trade dress protection *In re Dippin' Dots Patent Litig.*, 249 F. Supp. 2d 1346, 1373-74 (N.D. Ga. 2003).

70 USPQ2d at 1708-09.

In addressing the issue of "[w]hether DDI's product design is functional and therefore not subject to trade dress protection," *id.* at 1709, the Eleventh Circuit specifically indicated with respect thereto that (footnote omitted):

Section 43(a) creates a federal cause of action for trade dress infringement. *Ambrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1535 ... (11th Cir. 1986). "The term 'trade dress' refers to the appearance of a product when that appearance is used to identify the producer." *Publications Int'l, Ltd. v. Landoll, Inc.*, 164 F.3d 337, 338 ... (7th Cir. 1998). "'Trade [d]ress' involves the total image of a product and may include features such as size, shape, color ..., texture, graphics, or even particular sales techniques." *Ambrit*, 812 F.2d at 1535 (internal quotation omitted). In order to prevail on this claim for trade dress infringement under §43(a), DDI must prove that (1) the product design of the two products is confusingly similar; (2) the features of the product design are primarily non-functional; and (3) the product design is inherently distinctive or has acquired secondary meaning. *Epic Metals Corp. v. Souliere*, 99 F.3d 1034, 1038 ... (11th Cir. 1996); see also 15 U.S.C. §1125(a)(3) ("[T]he person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional."); *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29, 121 S. Ct. 1255, 1259, 149 L.Ed.2d 164 ... (stating that "trade dress protection may not be claimed for product

features that are functional"). "[A]s all three elements are necessary for a finding of trade dress infringement, any one could be characterized as threshold." *Epic Metals*, 99 F.3d at 1039. Because we conclude that DDI has not met its burden of establishing the non-functionality of its product design, we decline to address the other two elements of the claim.

Id.

Further, in its analysis of the functionality of applicant's trade dress, the Eleventh Circuit pointed out with respect to the functionality doctrine that (footnote omitted):

"The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature." *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164, 115 S. Ct. 1300, 1304, 131 L.Ed.2d 248 ... (1995); see also *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1336 ... (C.C.P.A. 1982) ("This requirement of 'nonfunctionality' ... has as its genesis the judicial theory that there exists a fundamental right to compete through imitation of a competitor's product, which right can only be temporarily denied by the patent or copyright laws."). "Functional features are by definition those likely to be shared by different producers of the same product and therefore are unlikely to identify a particular producer." *Landoll*, 164 F.3d at 340. "[T]hese features cannot be appropriated; otherwise, competitors would be prevented from duplicating the new product even to the extent permitted by the branches of the law of intellectual property that protect innovation rather than designations of source." *Id.*

The line between functionality and non-functionality is not ... brightly drawn." *Epic Metals*, 99 F.3d at 1039 (internal quotations omitted). Nonetheless, two tests exist for determining functionality. See *id.* Under the first test, commonly referred to as

the traditional test, "'a product feature is functional ... if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.'" *TrafFix*, 532 U.S. at 32, 121 S. Ct. at 1261 (quoting *Qualitex*, 514 U.S. at 165, 115 S. Ct. at 1304). Under the second test, which is commonly called the competitive necessity test and generally applied in cases of aesthetic functionality, "a functional feature is one the 'exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage.'" *Id.* (quoting *Qualitex*, 514 U.S. at 165, 115 S. Ct. at 1304). Where the design is functional under the traditional test, "there is no need to proceed further to consider if there is a competitive necessity for the feature." *Id.* at 33, 121 S. Ct. at 1262.

Id. at 1710.

In applying such test, and noting that "[t]he features of product design that we must analyze in this case are the size, color, and shape of dippin' dots," id., the Eleventh Circuit found that (footnotes omitted):

[T]he product design of dippin' dots in its individual elements and as a whole is functional under the traditional test. The color is functional because it indicates the flavor of the ice cream, for example, pink signifies strawberry, ... brown signifies chocolate, etc. See, e.g., *Qualitex*, 514 U.S. at 163, 115 S. Ct. at 1303 (explaining that "the words 'Suntost Marmalade,' on a jar of orange jam immediately ... signal a brand or a product 'source'; the jam's orange color does not do so"); *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 853, 856, 102 S. Ct. 2182, 2188-89, 72 L.Ed.2d 606 ... (1982) (concluding that district court did not err in finding that colors of certain prescription drugs were functional because, *inter alia*, many patients associated color with therapeutic effect); *Warner Lambert Co. v. McCrory's Corp.*, 718 F. Supp. 389, 396 ... (D.N.J. 1989) (finding that in the mouthwash field, an amber colored liquid signifies a medicinal-tasting product, red signifies a

cinnamon flavor, blue signifies peppermint, and green signifies mint). The district court took judicial notice of the fact that color indicates flavor of ice cream. DDI argues that such judicial notice was improper. We disagree.

....

In this case, the district court took judicial notice of the fact that color is indicative of flavor in ice cream. This fact is adjudicative in nature and is generally known among consumers. In addition, the district court specifically questioned DDI's counsel regarding the propriety of taking judicial notice of the fact[.]

....

.... Therefore, the district court properly took judicial notice of the fact that the color of ice cream is indicative of its flavor. Likewise, we, who also questioned DDI's counsel at oral argument regarding the propriety of taking judicial notice, take judicial notice of the fact that color of ice cream is indicative of flavor. Accordingly, we conclude that color is functional in this case because it is essential to the purpose of the product and affects its quality.

Size is also functional in this case because it contributes to the product's creamy taste, which would be different in a larger "dot." Plaintiff produced materials that emphasized how the quick freezing of tiny round beads was crucial to the taste and consistency of the product because the Patent '156 method of freezing tiny beads reduced the number of ice crystals in the product.

.... It necessarily follows that larger pieces of ice cream, which would take longer to freeze, would have increased ice crystals, thus affecting the creamy quality of the finished product. This is further evidenced by DDI founder Jones's Declaration of Commercial Success, submitted to the Patent Office, which emphasized dippin' dots' superior characteristics and benefits that are produced by using the Patent '156 method to create small pieces of ice cream.

These superior characteristics and benefits include the better taste and texture of dippin' dots, their easy dispensability, and the novel way in which they are consumed. In addition, several documents from the Patent '156 application denote the preferable size of the beads in specific millimeter measurements.

Likewise, the shape of dippin' dots is functional because dripping the ice cream composition into the freezing chamber, as described in Patent '156, creates a "bead" that facilitates the product's free flowing nature. Jones testified to this, stating he experimented with different procedures in order to create "a uniform bead" ..., and that the beaded shape of dippin' dots is a result of the method enunciated in Patent '156 Moreover, a DDI product brochure states that the spherical shape is a result of the Patent '156 process and allows the "quick, yet even freeze that is so important to the taste and consistency of the product."

Id. at 1710-12.

Thus, "[b]ased on our review of the record and dippin' dots' individual elements," id. at 1712, the Eleventh Circuit concluded that (emphasis in original):

[T]he totality of the dippin' dots design is functional because any flash-frozen ice cream product will inherently have many of the same features as dippin' dots. See *Landoll*, 164 F.3d at 342 (stating that when each of the elements is functional, "[i]f the product nevertheless present[s] a distinctive appearance, that appearance would be eligible for legal protection as trade dress *unless it [is] the only way the product [can] look, consistent with its performing each of the product's functions optimally*") (emphasis added). Therefore, DDI's product design as a whole is essential to its purpose and affects its quality. Accordingly, it is functional under the traditional test, and not subject to trade dress protection.

....

After a careful review of the record, we conclude that DDI's product design is functional as a whole and in its individual elements. To hold otherwise runs counter to intellectual property law because it would give DDI "a monopoly more effective than that of the unobtainable patent." See *Morton-Norwich*, 671 F.2d at 1337. "It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time." *Qualitex*, 514 U.S. at 164, 121 S. Ct. at 1304. Therefore, DDI's product design is not subject to trade dress protection. Accordingly, summary judgment in favor of FBD was proper.

Id. at 1713.

In view of the above findings as to size, color and shape in the civil litigation, and inasmuch as it is clear that applicant seeks to register as marks the configuration or trade dress of its products, individually (spherical shape) as well as composites (multiple spheres colored pink or brown), it is plain that the issue of the functionality of each of the putative marks sought to be registered by applicant has been finally adjudicated and that each of such marks has been determined to be functional. Hence, and inasmuch as it is also apparent that opposer has not lost interest in Opposition No. 91156483, the order to show cause issued in that case is considered discharged pursuant to Trademark Rule 2.128(a)(3); and, under the doctrine of issue preclusion (collateral estoppel), judgment is hereby entered against applicant and in favor of opposer with respect to the claims of functionality pleaded in these consolidated proceedings.

Opposition Nos. 91122465, 91156483 and 91159112

Decision: The oppositions are sustained and, in each case, registration to applicant is refused.